

Remarks

As stated above, Applicants appreciate the Examiner's thorough examination of the subject application and request reexamination and reconsideration of the subject application in view of the preceding amendments and the following remarks.

Claims 1-36 are pending in the subject application, of which claims 1 and 28 are independent claims. With this amendment Applicants have cancelled claims 3-20 and added new claims 21-36.

A. 35 U.S.C. §101 Rejection

The Examiner rejected claims 1-20 under 35 U.S.C. § 101 because the "claimed invention is directed to non-statutory subject matter." Office action, page 2. Applicants respectfully traverse this rejection.

An invention satisfies the statutory requirements of §101 if "it is tied to a particular machine or apparatus." *In Re Bilski* 2008 WL 4757110 (Fed. Cir. 2008)(en banc). A general purpose computer, when programmed to perform a particular function, is patentable subject matter under § 101. *In re Alappat*, 31 U.S.P.Q.2d 1545, 1558 (Fed. Cir. 1994). "[S]uch programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software." *Id.*

As amended, Applicants respectfully submit that claim 1 (and the dependent claims therefore, 2 and 21-27) is tied to a particular machine: it requires the use of computer capable of producing a multiple interfaces and various tools on those interfaces (amended claims, claim 1). The computer and user interface tie the process to a particular machine as described in *In re Bilski*. Such an amendment has support in specification paragraphs 4-18, and 41, as non-limiting

examples. Therefore, as amended, Applicant respectfully submits that claim 1, and subsequent claims 2 and 21-27 are allowable subject matter under §101 and respectfully request the removal of the §101 rejection.

Applicants respectfully submits that newly presented claim 28 (and subsequent dependent claims 29-36) are in condition for allowance under 35 U.S.C. §101 as well. These claims recite an apparatus in the form of "an article comprising a machine readable storage medium having a plurality of instructions stored thereon, which when executed by a processor, cause the processor to perform [various] operations" (Amended claims, claim 28). It is Applicants' understanding that these claims are patentable as well. See *In Re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

B. 35 U.S.C. §112 Rejection

The examiner rejected claims 1-11 as "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office action, page 4. In particular, claims 1-2 were rejected under 35 U.S.C. §112 as the claims "recite[d] a method claim wherein the claim limitations only consist of structural limitations." *Id.* As amended, claim 1 (and subsequent dependent claim 2) recites a proper method claim in that the actions of "providing a first interface," "providing a second interface" and "providing one or more tools" have been amended into the claims (see amended claims, claim 1). Applicants respectfully submit that these amendments are sufficient to distinctly and properly claim the subject matter claimed in view of 35 U.S.C. §112.

In the present action, Applicant has cancelled claims 3-11, obviating the examiner's rejection with respect to these claims.

C. 35 U.S.C. § 102 Rejection

Claims 1-17 were rejected under 35 U.S.C. §102(e) as anticipated by Marpe, et al. (U.S. Patent No. 6,671,692, "Marpe"). Applicants respectfully submit that the amended claims overcome these rejections.

Claim 1 has been amended and reproduced below for the examiner's convenience.

1. (currently amended) A method for planning a merger of at least two organizations on a computer, the method comprising:
 - providing a first interface for a first organization adapted to allow a user to plan a project with a resource management capability and a time management capability;
 - providing a second interface for a second organization adapted to provide collaborative capabilities to a plurality of merger members to plan the project with said resource management and said time management, said first and second interfaces forming a collaborative workspace between said first organization and said second organization; and
 - providing one or more tools graphically displayed on at least one of said interfaces adapted to allow a user to exchange merger information and aid in collaboration with a person said plurality of said organizational members associated with one of the organizations;
 - wherein said one or more tools provide one or more graphically displayed features including:
 - a feature for defining one or more milestones,
 - a feature for choosing one or more resources to assign to one or more tasks or said one or more milestones,
 - a feature for selecting when said one or more tasks is scheduled for completion, and
 - a feature for detecting and displaying interdependencies between tasks.

Amended claim set, claim 1.

Applicants respectfully submit that the added limitations within newly amended claim 1 present a claim which is not anticipated by Marpe. Particularly, Applicants submit that Marpe fails to disclose two interfaces providing a set of tools, "wherein said one or more tools provide one or more graphically displayed features including a feature for defining one or more milestones, a feature for choosing one or more resources to assign to one or more tasks or said one or more milestones, a feature for selecting when said one or more tasks is scheduled for completion, and a feature for detecting and displaying interdependencies between tasks."

Amended claim set, claim 1. It is Applicants' understanding that Marpe discloses a method for searching databases of multiple organizations and does not disclose these elements. Applicants, therefore, respectfully submit that claim 1 as well as subsequent dependent claims 2 and 21-27 are in condition for allowance with respect to Marpe, as are newly presented claims 28-36.

D. 35 U.S.C. § 103 Rejections

The examiner previously rejected claims 18-20 under 35 U.S.C. §103(a) as being unpatentable over Beringer (U.S. Pat. # 7,219,107) in view of Marpe. Applicants have cancelled claims 18-20, thereby obviating these rejections.

E. Newly Presented Claims

Applicants have additionally amended the claim set to include new claims 21-36. As discussed above, these new claims are also believed to be in condition for allowance. These newly presented claims include 1 new independent claim, claim 28. Claims 28-36 are directed towards an article comprising a machine readable storage medium, storing instructions operable to cause a machine to perform operations that are similar to what is claimed in claims 1, 2, and 21-27. In light of the above, Applicants respectfully submit that these claims are in condition for allowance.

F. Conclusion

In light of the cancellation of claims 3-20, Applicants submit that the newly amended claim set dose not incur any additional fees despite the addition of claims 21-36, as the claim set now contains 18 total claims, with 2 independent claims (previously, Applicants submitted 20 total claims, with 7 independent claims). Therefore, this response is not believed to necessitate any additional fees. However, in the event that additional fees are due, please charge or credit any refund to our Deposit Account No. 50-2324.

Appl. No. 10/749,865
Response Dated December 12, 2008
Reply to Office action of September 12, 2008
Attorney Docket No. 103580.00020

Page 15 of 15

While the Applicants respectfully assert that the subject application is now in condition for allowance, the Examiner is invited to telephone Applicants' attorney (@ 617-305-2143) to facilitate / expedite prosecution of this application. Allowance of the subject application is respectfully solicited.

Respectfully Submitted,

Dated: 12 December 2008

/Brian J Colandreo/
Brian J Colandreo
Reg. No. 42,427

Holland & Knight LLP
10 St. James Avenue
Boston, MA 02116-3889
Telephone 617-305-2143
Facsimile 617-523-6850

5847114_v1